UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,688	11/14/2001	Takeo Morinaga	SONYJP-135	3830

530 7590 09/14/2006

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER	
NGUYEN, TANH Q	

ART UNIT	PAPER NUMBER
2182	

DATE MAILED: 09/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/913,688	MORINAGA, TAKEO	
	Examiner	Art Unit	
	Tanh Q. Nguyen	2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,7-20 and 25-38* is/are pending in the application.

4a) Of the above claim(s) *8-18,25-34,36 and 38* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,7,19-20,35 and 37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *27 June 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 2, 7, 19, 20, 35, 37 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an index adding means for adding an updated address to a TS packet showing an address on the recording means [page 17, lines 11-21; page 24, lines 1-5], does not reasonably provide enablement for the index adding means for adding an updated address on the recording means. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. The index adding means only adds an updated address to a TS packet, which is inputted to a selector, a recording means interface before being recorded on a recording means [page 17, lines 11-21], or the index adding means only adds an updated address when the transport stream as a processing target is recorded on the recording means [page 24, lines 1-5]. The index adding means does not add an updated address on the recording means.

3. Claims 2, 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed,

had possession of the claimed invention. The examiner cannot find support in the specification for "said DMA-transferring is made **bit by bit** by a block of a predetermined data amount", as recited in lines 4-5 of the respective claims. Applicant is required to specifically point out the location for such limitation in the specification (i.e. by page, line number and/or by drawing label and drawing number) or amend the claims accordingly.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claim 37 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 37 recites "A recording medium in which a computer-readable program has been recorded, wherein said program comprises: receiving...". A computer program is static when not executed, hence cannot comprise an action such as receiving.

It appears that applicant meant to recites "A recording medium in which a computer-readable program has been recorded, wherein said program when executed, comprises the steps of: receiving...".

6. The rejections that follow are based on the best interpretation of the claims.

Claim Rejections - 35 USC § 102

7. Where the specification identifies work done by another as "prior art," the subject

matter so identified is treated as admitted prior art. In re Nomiya, 509 F.2d 566, 571, 184 USPQ 607, 611 (CCPA 1975) (holding applicant's labeling of two figures in the application drawings as "prior art" to be an admission that what was pictured was prior art relative to applicant's improvement). Accordingly 35 USC 102 would form the basis for the rejections that follow.

8. Claims 1, 7, 19, 35, 37 are rejected under 35 U.S.C. 102 as being anticipated by Applicant Admitted Prior Art (AAPA: pages 1-9 and FIG. 1).

9. As per claim 1, AAPA teaches an information processing apparatus [a digital broadcast receiving apparatus - FIG. 1] comprising:

receiving means [12, 13, FIG. 1] for receiving a stream constructed by packets of a predetermined format;

extracting means [21, FIG. 1] for extracting packets for recording to a recording means [15, FIG. 1] from the packets constructing said stream received by said receiving means;

memory means [23, FIG. 1] for storing said packets for recording;

DMA commands to access the hard disk drive [29, FIG. 1; page 8, lines 14-16], hence a command buffer for forming a command for instructing a DMA transfer;

transfer preparing means [1, FIG. 1] for permitting DMA-transferring and issuing an end status [permitting DMA-transferring and issuing an end status (i.e. setting of transfer start) conventionally processed by host CPU - page 9, lines 11-15];

index adding means for adding an updated address on the recording means when said end status is issued [the setting of the LBA and setting of transfer start

conventionally processed by host CPU - page 9, lines 11-15]; and

transfer means for DMA-transferring said packets for recording to the recording means in accordance with said command formed in said command buffer and said address from said index adding means,

10. As per claim 7, 19, AAPA further teach the recording means being a hard disk drive [15, FIG. 1] built in said information processing apparatus [FIG. 1].

11. As per claims 35, 37, the claims generally correspond to claim 1 and are rejected on the same bases.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 2, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of in view of Mergard (US 5,881,248).

AAPA teaches the memory means including an input FIFO [23, FIG. 1] and the DMA-transferring being made by a block of a predetermined amount [by an DMA descriptor/command]. AAPA does not teach the DMA command being formed when the data amount of the packets stored in the memory means reaches a full capacity.

Mergard teaches forming a DMA command when the data amount of the packets stored in the memory means reaches a predetermined capacity in order to prevent the

memory from overflowing [col. 7, lines 13-14], the predetermined capacity being less than the full capacity of the memory.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to form a DMA command when the data amount of the packets stored in the memory means reaches a predetermined capacity, as is taught by Mergard, in order to prevent the memory from overflowing.

Response to Arguments

14. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tanh Q. Nguyen whose telephone number is 571-272-4154. The examiner can normally be reached on M-F 9:30AM-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh can be reached on 571-272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 9, 2006

TQN
September 9, 2006